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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,085	05/24/2000	Richard Palmeri	1008-00	4564

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IP DEPARTMENT OF PIPER RUDNICK LLP  
3400 TWO LOGAN SQUARE  
18TH AND ARCH STREETS  
PHILADELPHIA, PA 19103

EXAMINER

BUI, THACH H

ART UNIT PAPER NUMBER

3628

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/578,085

Applicant(s)

PALMERI, RICHARD

Examiner

Thach H Bui

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-7, 17-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea.

The Examiner notes that the disclosed invention is within the technological arts. The claimed invention is also noted not to be a computer program, data structure, a natural phenomenon, and a non-descriptive material per se. The claimed invention does not include a series of steps to be performed by a computer. The claimed invention also is not a product for performing a process, nor it is a specific machine or manufacture. The claimed invention is not a specific tangible machine or process for facilitating a business transaction. Claims 1-7, 17-22 do not appear to correspond to a specific machine or manufacture disclosed within the instant specification and thus encompasses any product of the class configured in any manner to perform the underlying process. The claimed invention of claims 1-7, 17-22 also does not include a post-computer process activity or a pre-computer process activity. Thus, no physical transformation is performed, no practical application in the technological art is found. Consequently, claims 1-7, 17-22 are analyzed based upon the underlying process, and are thus rejected as being directed to a non-statutory process.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 5-6, 8, 11-15, 17, 19-21, 23, and 26-28 as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffman.

As per claim 1, Hoffman discloses a method of electronically reallocating a transaction amount between a user and a vendor comprising at least one user account (14), and at least one vendor account (12). The system includes an electronic distributing means to distribute a transaction amount from the user account to the vendor account (see Figure 2). The system also comprises at least one user trust fund or investment fund wherein the transaction amount is being electronically distributing from the vendor account to the user trust fund account or the investment account (column 4, lines 30-69; column 5, lines 1-69; column 6, lines 1-15).

As per claim 2, the claimed invention is mentioned in the above paragraph.

As per claim 5, Hoffman discloses an interactive information source between the user and the user trust fund/investment account, whereby the user trust fund/investment account provides information to the user (see Figure 3).

As per claim 6, Hoffman also teaches an interactive information source is a web site (column 1, lines 3-40; column 12, lines 1-33) (see Figures 2 and 3).

As per claim 8, Hoffman discloses a system having at least one user institution comprising at least one user account and a user account's processing unit (see Figure 3). The system also includes at least one vendor institution (see Figure 2) having at least one vendor and a vendor's account transaction processing unit. Further, Hoffman teaches at least one money transfer system (electronically distributed) that is in communication with the vendor.

As per claim 11, Hoffman discloses a user identification system i.e. customer No. 123 and customer No. 234 (see Figures 1 and 2).

As per claims 12-15, 17, 19-21, 23, and 26-28, the claimed inventions are discussed in the above paragraphs.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-5, 9-10, 16, 18, 24-25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman.

As per claim 3, 4, 18 and 25, Hoffman has all the features of the invention but lacks a second user account. Hoffman teaches a customer deposit account. It would have been obvious to one having ordinary skill in the art to have multiple accounts i.e.

Art Unit: 3628

checking account, saving account and etc. Having multiple accounts will help the user to organize his or her funds.

As per claim 5, the system of Hoffman teaches providing information to a user regarding transaction amount placed in the investment vehicle. Such is deemed necessary for providing up to date information to users regarding their account.

As per claims 9, 10 and 24, Hoffman does not explicitly mention the account managers for the user and the vendor. However, Hoffman teaches statements or invoices that itemized all the transactions that occurred. This feature would indicate that there is an account manager that keeps track all records in order to provide a detailed summary for all the transactions (see Figure 3).

As per claims 16, 22, and 29, kiosk systems are well-known and used in the art. Implementing the system of Hoffman in a kiosk would have been obvious to the skilled artisan in order to provide easy access to many potential customers (such as easy access in a mall).

### ***Response to Arguments***

4. Applicant's arguments filed November 25, 2002 have been fully considered but they are not persuasive.

5. The Examiner rejected claims 1-7, 17-22 under 35 U.S.C 101 because the claims are merely an abstract idea as the method does not involve any computer or structural means to carry any functions. Applicant indicated that "the claims clearly provide a practical application and are, in fact, a statutorily protectable process in that

electronically moving funds from a transaction from one location to another for placement into an investment vehicle is clearly a practical application". Examiner disagrees. 35 U.S.C. 101 states "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title". The claims 1-7, 17-22 clearly are not directed to machines, manufactures, or compositions of matter.

The Supreme Court in *Diamond v. Diehr*, 450 U.S. 175, 184, 209 USPQ 1, 6 (1981), explained:

In defining the nature of a patentable process, the Court stated:

"That a process may be patentable, irrespective of the particular form of instrumentalities used, cannot be disrupted. A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state of thing... The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence. *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1876)."

The Court further referenced a definition of "process" given in *Corning v. Burden*, 15 How. 252, 267-268 (1853), wherein the Court stated:

"The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation

or application of some element or power of nature, or of one substance to another, such modes, methods, or operations, are called processes... It is when the term process is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations."

6. The Examiner applied the rejection using prior art Hoffman (U.S. patent 5,297,026) base solely on the written claims of this application. The prior art discloses the steps and/or features that described in this application; and therefore, it is being rejected. Hoffman discloses an electronically distributing at least a portion of the transaction amount from the vendor i.e. investment institutional (76) (see figure 3) to the user trust account i.e. customer deposit account (18) (see Figure 3), wherein the portion of the transaction amount in the user trust account and/or deposit account is placed in an investment vehicle (50) (see Figure 2).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hoffman teaches a mean to transfer a portion of the transaction amount in the user trust account and/or deposit account and placed in an investment vehicle.



Applicant's arguments have been addressed in the above paragraphs.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

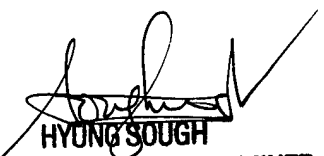
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thach H Bui whose telephone number is 703-305-0063. The examiner can normally be reached on Monday-Friday, 7:30-4 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Art Unit: 3628

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

T.B.  
May 30, 2003



HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600